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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/692,920

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Robert O. Banker

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11/18/2004

Scientific-Atlanta, Inc.
Intellectual Property Dept. MS 4.3.510
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EXAMINER

BELIVEAU, SCOTT E

ART UNIT

PAPER NUMBER

2614

11

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/692,920

Applicant(s)

BANKER ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120. In particular, the later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). The earlier 09/590,488 application illustrates an "indexing function" in Figure 8C, however it does not disclose details as to the particular usage of the illustrated function as claimed.
2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-38 of this application. In particular, while the provisional application notes the ability to index listings with left and right arrows by selectable categories such as year or rating (Page 8), the reference fails to adequately disclose the particularly claimed invention comprising an "indexing prompt" such that the user is provided with "media titles corresponding to an indexing parameter associated with said indexing prompt". For example, it is unclear if the provisional necessarily allows a user to select to index by year and then to designate a particular parameter (ex. 1990). Accordingly, the instant application shall be examined on the basis of its filing date or 20 October 2000.

Drawings

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3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 88 (Figure 4); 113 (Figure 5); 206 (Figure 15). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include reference sign "175" (Page 15, Line 20) mentioned in the description. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “highlighting a second indexing prompt associated with a second media title in response to receiving user input designating said second media title to be highlighted” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

6. Applicant is advised that should claim 1 be found allowable, claim 2 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an

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application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 11, 26, and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, the specification fails to describe how “in response to receiving user input designating said second media title to be highlighted” that a “second indexing prompt associated with a second media title” is highlighted. The subject matter appears to be directed towards the feature wherein the list of titles does not only include those titles belonging to the selected category that matches the highlighted indexing parameter. However, while the specification is enabling for highlighting a title in response to the selection of a indexing criteria, the opposite is not enabled.

Claim Rejections - 35 USC § 102

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9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-15 and 17-38 are rejected under 35 U.S.C. 102(b) as being anticipated by LaJoie et al. (US Pat No. 5,850,218).

In consideration of claims 1, 2, 17, and 28, the LaJoie et al. reference discloses a method for “providing media information to a user” implemented via the “means” associated with a “media services client device” [6] comprising a “processor” [30] and “memory” [32] and coupled to a “programmable media services service device” [15]. The method comprises “presenting an interactive media guide . . . to the user” (Figure 16) having an “indexing prompt” [360/362/364] whereupon subsequent to “receiving user input identifying said indexing prompt”, the user is “provided with media titles corresponding to an indexing parameter associated with said indexing prompt” (ex. index by parameters associated with Time, Theme, and/or Title) (Figures 17-23; Col 26, Line 27 – Col 28, Line 51).

Claims 3, 19, and 30 are rejected wherein the “indexing parameter is selected from a group consisting of: an alphanumeric character . . .” (Figure 22; Col 27, Line 64 – Col 28, Line 26).

Claims 4, 20, and 31 are rejected wherein the “media titles are indexed by an indexing characteristic selected from a group consisting of: title name . . .” (Figure 22; Col 27, Line 64 – Col 28, Line 26).

Claims 5, 6, 21, 22, 32, and 33 are rejected wherein the method comprises “receiving user input identifying an indexing characteristic by which the media titles are indexed” such that the user may designate an indexing characteristic such a theme and may subsequently designate secondary indexing parameter such as title (Col 27, Lines 24-33).

Claims 7, 23, and 34 are rejected wherein the “user input is initiated by the user pressing an arrow button on a remote control” (Col 26, Lines 27-64).

Claims 8, 24, and 35 are rejected wherein Figures 17-23 illustrate that the “interactive media guide includes a plurality of indexing prompts and a plurality of media titles”.

Claims 9, 25, and 36 are rejected wherein Figure 20 illustrates a “first indexing prompt and a first media title associated with said first indexing prompt are highlighted” (Col 26, Line 64 – Col 27, Line 7).

Claims 10, 25, and 37 is rejected wherein the system “highlights a second media title associated with a second indexing prompt in response to receiving user input designating said second indexing prompt to be highlighted” (Col 28, Lines 5-15). For example, in response to identifying a new indexing prompt (ex. By Title), a “second media title” corresponding to the program selected while in the prior mode is highlighted.

In consideration of claims 11, 26, and 38, the reference discloses that the system is operable to display titles that do not correspond to a selected index parameter (Col 6, Lines 29-46). Furthermore, the reference is operable to “highlight a second indexing prompt” [430] “associated with a second media title” in “response to receiving user input designating said second media title to be highlighted” (Col 28, Lines 5-15). For example, in response to highlighting a second title associated with a “Movie” while in the Title mode, the user upon

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navigating to the Theme mode result in the “index prompt” corresponding to the movie theme to be highlighted. The claim does not particularly preclude additional steps involved in the process, nor does it require any particular composition of the “second indexing prompt”.

In consideration of claims 12-14, the system inherently provides for “receiving input from a system operator for determining a feature of an indexing prompt”, “for determining a feature of an indexing parameter”, and “for determining a feature of the media titles” in so far as the media guide presented to the user is a computer application derived from the application server which at some point in time must have been developed through inputs of “system operator” so as to particularly appear and present the particular options illustrated in the corresponding Figures of LaJoie et al.

Claims 15, 18, and 29 are rejected wherein “only titles belonging to a sub-list of media titles are provided to the user” (Col 6, Lines 29-46)

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent

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any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over LaJoie et al. (US Pat No. 5,850,218)

In consideration of claim 16, the LaJoie et al. reference discloses that the media guide and associated functionality is provided to cable subscribers. The reference, however, does not explicitly that cable subscribers are "charged a fee in connection with the provision of indexing functionality" associated with being allowed to access the cable provider's network/services. The examiner takes OFFICIAL NOTICE that it is notoriously well known in the art for cable service providers, such as Time Warner Cable (the assignee of the LaJoie et al. reference), to charge a fee in connection with subscribing to their services including the ability to access an interactive media guide. Accordingly, it would have been obvious, if not implicit to the reference, to one having ordinary skill in the art at the time the invention was made to "charge the user a fee in connection with the provision of indexing functionality" for the inherent advantages associated with charging subscribers usage fees including but not limited to the ability of the service provider to re-coup costs and profit from providing cable services.

Conclusion

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Randal et al. (WO 98/56173 A1) reference discloses an apparatus and method for searching and sorting channel guide information.
- The Beach et al. (US Pub. No. 2003/0014753) reference discloses an interactive guide that enables users to search a database of program guide information according to indexed program attributes.
- The Billock et al. (US Pat No. 5,619,249) reference discloses an interactive interface that provides viewers with the ability to index video-on-demand programming.
- The Schein et al. (US Pat No. 6,133,909) reference discloses a system and method for searching for programming based upon indexed attributes.
- The Lemmons et al. (US Pat No. 5,880,768) reference discloses an interactive program guide that enables a user to designate filter and sort criteria.
- The Rowe et al. (US Pat No. 5,623,613) reference discloses a system for retrieving and displaying programming information in response to the selection of category and sub-category information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907.


The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB
November 8, 2004



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